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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,199	03/30/2001	Ronald W. Marsh	P-4154P1	1238

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EXAMINER

LAM, ANN Y

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 12/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/823,199

Applicant(s)

MARSH ET AL.

Examiner

Ann Y. Lam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Heck, 6,083,207. Heck discloses an elongate tube (12) defining a longitudinal axis having a proximal end, a distal end and an axial hollow bore, a hub (38) having a proximal end, a distal end and an open passageway therethrough, said hub being attached to said elongate tube so that said hollow bore of said elongate tube is in fluid communication and substantial axial alignment with said open passageway, said hub further having a cavity therein disposed between said proximal end and said distal end of said hub; a resilient member (catheter or medical device, see column 5, line 33 and column 6, lines 50-53) having an opening therethrough defining an inner diameter and disposed in said

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cavity so that said opening is substantially axially aligned and in fluid communication with said open passageway; and a clamp (70, 71 and 56) selectively movable between an open position wherein said inner diameter member is substantially unaffected and a clamp position wherein said clamp causes a strain to at least a portion of said resilient member thereby reducing said inner diameter of said opening through at least a portion of said resilient member, see column 6, lines 36-53.

As to claim 2, at least a portion of said clamp (70, 71) projects outwardly from said hub.

As to claims 3 and 12, said portion of said clamp that projects outwardly from said hub further includes a releasable latch (102).

As to claims 4 and 13, a push tab (edge of 102) extends away from the releasable latch (90), see Figure 3.

As to claims 5 and 14, the push tab is oriented for movement perpendicular to the elongate tube, see Figure 5.

As to claims 6 and 15, a support leg (i.e., portion of 102 that is attached to 26) limits movement of the latch, see Figure 3.

As to claims 7 and 16, the clamp (70, 71) includes a pair of legs defining at least one radiused portion (e.g., proximal portion of 70, 71) therein, see Figure 5.

As to claims 8 and 17, the resilient member (catheter or medical device, see column 5, line 33 and column 6, lines 50-53 ) defines a radiused portion and the radiused portion of the pair of legs is considered to have a radius substantially the same as the radiused portion of the resilient member.

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As to claims 9 and 18, the pair of legs defines a second radiused portion (e.g., distal portion of 70, 71) adjacent to the at least one radiused portion.

As to claim 10, an epidural needle is disclosed at (12 and 202) and a spinal needle as claimed is the catheter or medical device disclosed in column 5, line 33 and column 6, lines 50-53.

As to claim 11, the spinal needle is considered to include an indicia (for example, the proximal end of spinal needle) for providing indication to the practitioner of the location of the spinal needle with respect to the epidural needle.

As to claim 19, the resilient member is distinct from the elongate tube, and is deformed.

As to claim 20, the clamp (70, 71, 102, 104) comprises a deformable U-shaped member having an apex and two legs, wherein a living hinge is disposed at the apex and a latch (102) is disposed on the legs, see Figure 3.

### ***Response to Arguments***

Applicant's arguments with respect to the above rejected claims have been considered but are moot in view of the new ground(s) of rejection. The medical device, which could be a catheter, see column 5, line 33, and column 6, line 52, is considered to be the claimed resilient member. Heck discloses that the medical device (catheter) is forced between the lips (56), see column 6, lines 52-53. Thus, clamp (70, 71, 56) causes a strain to at least a portion of said resilient member (i.e., the catheter) thereby

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reducing said inner diameter of said opening through at least a portion of said resilient member, as claimed by Applicant.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is (703) 306-5560. The examiner can normally be reached on T-F 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703)308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

A.L.

December 1, 2002

ANHTUAN T. NGUYEN  
PRIMARY EXAMINER